

REMARKS

The above referenced patent application has been reviewed in light of the Office Action, dated July 14, 2004, in which:

- the drawings are objected to under 37 C.F.R. § 1.84(u);
- the disclosure is objected to due to the drawings;
- the title is objected to as not being sufficiently descriptive;
- claims 3-9, 12-15, 23, 33, and 34 are objected to as being dependent upon rejected claims;
- claims 1, 2, and 10 are rejected under 35 U.S.C. § 102(b) on Nelson *et al.* (hereafter, 'Nelson,' US Patent No. 5,724,274);
- and claims 11, 16-22, 24-32, and 35-45 are rejected under 35 U.S.C. § 102(e) on Wilke (US Patent No. 6,633,445 B1).

Reconsideration of the above referenced patent application in view of the foregoing amendments and the following remarks is respectfully requested.

A Petition for Extension of Time in order to extend the period for response 3 month(s), including the appropriate fee, is filed herewith.

Claims 1, 2, 4-10, and 12-15 are now pending the above referenced patent application. No claims have been added. Claims 1, 11, 12, and 15 have been amended to address minor matters of form, and, therefore, do not result in prosecution history estoppel and do not alter the scope of the claims as originally filed. No new matter has been entered. Claims 3, 11, and 16-45 have been cancelled; however, Applicant intends to pursue the cancelled claims to issuance in a

continuation patent application of the current pending application, serial no. 09/900,823.

Therefore, no prosecution history estoppel or change in scope of the claims should result from the foregoing cancellations.

1. Request for Clarification

1.1. Information Disclosure Statement: 37 C.F.R. § 1.98(b)(5)

The PTO has considered the IDS but has noted that the publication dates of the reference where inadvertently omitted. As the IDS has been considered and signed by the Examiner, Applicant is confused as to whether or not the PTO would like the IDS resubmitted or if a statement within the current response is sufficient. Unless notified otherwise, Applicant assumes that the PTO feels that the Duty of Disclosure requirement has been fulfilled by citing the dates within this response, directly below.

The byline of the David Coursey article (<http://www.zdnet.com/> ...) states it was published March 15, 2001.

The Laplink publication (<http://www.laplink.com/> ...) is a dynamically generated web page. See the publication's ASP extension. Therefore, it is respectfully asserted that it was published on the date of access and printing July 2, 2001, as noted in the footer of the submitted hardcopy.

2. Objections

2.1. Drawings: 37 C.F.R. § 1.84(u)

The PTO has objected to the drawings under 37 C.F.R. §1.84 as failing to include label the 3 illustrated states, unconnected, mounted, and unmounted, as figures (a), (b), and (c), respectively. Please find submitted concurrently herewith updated formal drawings. Both Figs. 1 & 2 are amended to include the requested reference labels. Applicant respectfully submit that the drawings filed concurrently herewith are formal drawings complying with 37 C.F.R. § 1.84. Therefore, Applicant respectfully submits that the objections to the drawings have been overcome.

2.2. Disclosure: Due to Drawings

The PTO has objected to the disclosure due to the drawings as failing to discuss the 3 illustrated states, unconnected, mounted, and unmounted, as figures (a), (b), and (c), respectively, and failing to discuss elements 151 and 251. Applicant has added paragraphs to the disclosure detailing Figs. 1a, 1b, 1c, 2a, 2, and 2c. Applicant has also removed the labels 151 and 251 from the drawings. Applicants respectfully submit that the amendments to the specification and the drawings are sufficient to overcome the PTO's objection. Therefore, Applicants respectfully submit that the objections to the disclosure have been overcome.

2.3. Title: Insufficient Description

The PTO has objected to the title as being insufficiently descriptive. While Applicant respectfully disagrees, rather than belabour the point, Applicant has amended the title to include the multi-ported nature of the disclosed subject matter. Applicant respectfully submits that the title is sufficiently descriptive to overcome the PTO objection.

If the PTO does not agree, they are urged to contact the undersigned at 503-264-7002, and propose a new title so that the objection may be overcome via Examiner's Amendment.

2.4. Dependent Claims: 3-9, 12-15, 23, 33, and 34

The PTO has objected to claims 3-9, 12-15, 23, 33, and 34 are objected to as being dependent upon rejected claims.

2.4.1. Claims 3-9

The PTO has objected to claims 3-9, 12-15, 23, 33, and 34 are objected to as being dependent upon a rejected base claim (claim 1). However, the claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant has rewritten claim 1 (the base claim) to correspond with claim 3 if it had been rewritten in independent form with all the limitations of the base claims and any intervening claims. Claim 3 has been cancelled. Therefore, Applicant respectfully asserts that claims 3-9 no longer depend upon a properly rejected base claim and should be allowed. Applicant respectfully submits that the objections to the claims have been overcome.

2.4.2. Claims 12-15

The PTO has objected to claims 12-15 are objected to as being dependent upon a rejected base claim (claim 11). However, the claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant has rewritten claim 12 in independent form with all the limitations of the base claims and any intervening claims. Claims 13 & 15 have been amended to depend upon claim 12. Therefore, Applicant respectfully asserts that claims 12-15 no longer depend upon a properly rejected base claim and should be allowed. Applicant respectfully submits that the objections to the claims have been overcome.

2.4.3. Claims 23, 33, and 34

The PTO has objected to claims 23, 33, and 34 are objected to as being dependent upon a rejected base claim. However, the claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant has cancelled claims 23, 33, and 34; however, Applicant intends to pursue the cancelled claims to issuance in a continuation patent application of the current pending application, serial no. 09/900,823. Therefore, no prosecution history estoppel or change in scope of the claims should result from the foregoing cancellations. Applicant respectfully submits that the objections to the claims have been overcome.

3. 35 U.S.C. § 102

3.1. *Nelson: Claims 1, 2, and 10*

The PTO has rejected claims 1, 2, and 10 under 35 U.S.C. § 102(b) as being anticipated by Nelson. This rejection by the PTO of these claims is respectfully traversed.

It is well-established that in order to establish a *prima facie* case of anticipation under § 102 of the patent statute, the PTO must provide a single prior art document that alone has every element and every limitation of the claim being rejected. Therefore, if even a single element or limitation is not met by the asserted document, then the PTO has not succeeded in establishing a *prima facie* case.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants begin with claim 1. Claim 1, as amended, recites:

1: (Currently Amended) A method for transferring digital data comprising:
removing a first mass storage device from an information handling system;
reading at least a portion of digital data from said first mass storage device while
said first mass storage device is operated with said information handling system while
said first mass storage device is unmounted; and
storing said digital data read from said first mass storage device to a second
mass storage device mounted with said information handling system;
wherein said first mass storage device includes:
a first data port, said first data port having a configuration so as to be utilized
when said first mass storage device is operated while mounted with said information
system, and
a second data port, said second data port having a configuration so as to be
utilized when said first mass storage device is operated with said information system
while said first mass storage device is unmounted.

It is respectfully asserted that, as just one example of how the text cited by the PTO fails to meet the language of the rejected claims, Nelson does not show, teach, use, or describe a first mass storage device as described in lines 9-14 of Claim 1. Furthermore, Applicant asserts that the amended claim 1 is essentially the objected to dependent claim 3 rewritten in independent form including all the limitations of the base and any intervening claims. Applicants, therefore, respectfully contend that Nelson fails to satisfy a *prima facie* case of anticipation as directed by 35 U.S.C. § 102.

Claims 2 and 10 either depend from claim 1, or include a substantially similar and patentably distinct limitation as claim 1. It is, therefore, respectfully requested that the rejection of these claims also be withdrawn.

3.2. Wilke: Claims 11, 16-22, 24-32, and 35-45

The PTO has rejected claims 11, 16-22, 24-32, and 35-45 under 35 U.S.C. § 102(e) as being anticipated by Wilke. This rejection by the PTO of these claims is respectfully traversed; however, Applicant contends that, given the cancellation of the claims, the issue is moot in the current patent application.

Applicant has cancelled claims 11, 16-22, 24-32, and 35-45; however, Applicant intends to pursue the cancelled claims to issuance in a continuation patent application of the current pending application, serial no. 09/900,823. Therefore, no prosecution history estoppel or change in scope of the claims should result from the foregoing cancellations. It is, therefore, respectfully requested that the rejection of these claims also be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,



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Dated:

Sun Dec 19, 2004

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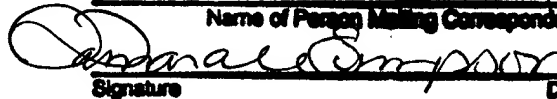
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